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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,892	10/26/2001	Howard E. Preissman	PALX-003DIV	8727
21394	7590	12/28/2004	EXAMINER	
ARTHROCARE CORPORATION 680 VAQUEROS AVENUE SUNNYVALE, CA 94085-3523			PRIDDY, MICHAEL B	
			ART UNIT	PAPER NUMBER

3732

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,892

Applicant(s)

PREISSMAN, HOWARD E.

Examiner

Michael B Priddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 5-14, 28-37 and 43-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 15-27 and 38-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Though not explicitly stated and only implied by the statement of the last office action that claims 1-4, 15-27 and 38-42 were going to be considered, Claims 43-51 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 02/23/2004.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 15-18, 20-23, 25-27 and 38-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Perler (U.S. 4,863,072). Perler teaches a high pressure applicator for driving the delivery of a flowable tissue implant material, comprising: a first column 12 having an inner wall, an outer wall, a first end, a second end having an orifice 44 for delivering implant material therethrough; a second column 14, said second column being drivable with respect to said first column to generate a pressure within said first column 12; and a handle 16 attached to said first column 12 and radially extending therefrom to provide a user mechanical advantage upon grasping said handle

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16; at least one O-ring 23 mounted to an end portion of said second column 14 and interfacing with said inner wall of said first column 12; wherein said second column 14 comprises a wall which is drivably engageable with one of said inner and outer walls; a handle 18 integrally formed with or affixed to and extending radially from said second column 14 to provide the user a mechanical advantage upon grasping said handle 18; threading 38 on at least a portion of said inner wall of said first column 12, wherein said wall of said second column 14 is an external wall comprising threading 22 along at least a portion thereof, said threading 22 of said external wall being engageable with said threading 38 on at least a portion of said inner wall; wherein said threading 22 covers only a portion of said second column 14 external wall, an end portion of said second column 14 being relatively smooth; wherein only a portion of said inner wall comprises threads, the remainder 46 of said inner wall being substantially smooth; wherein said relatively smooth end portion comprises a reduced diameter section 48 having an outside diameter less than an inside diameter of said threads 38 on said inner wall, and an enlarged section 24 which closely fits with said substantially smooth inner wall 46 to form a pressure seal therewith; wherein said pressure seal is enhanced by said O-ring 23.

Concerning the limitations of claims 38-42 which require the applicator be capable of generating pressures of at least about 1000psi; 1500psi; up to about 2000psi; 2500psi; and/or 3000psi, it is the Examiner's view that since the structure of Perler is fully functionally equivalent if not identical to that claimed, the applicator of Perler is capable of generating the pressures claimed.

Claims 1 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Fischer (U.S. 5,603,701). Fischer teaches a high pressure applicator for driving the delivery of a flowable tissue implant material, comprising: a first column 12 having an inner wall, an outer wall, a first end and a second end having an orifice for delivering implant material therethrough; a second column 16, said second column being drivable with respect to said first column 12 to generate a pressure within said first column 12; and a handle 28 attached to said first column 2 and radially extending therefrom to provide a user a mechanical advantage upon grasping said handle 28; wherein said first column 12 comprises a removable section 14 adapted to be removed from said first column 12 for drivably engaging said first 12 and second 16 columns.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perler in view of Phillips (U.S. 4,032,118). Perler, as presented above, teaches all of the limitations of the present invention except the at least one sealing element comprises a Teflon wrap.

Phillips teaches a sealing means for stirring apparatus. The sealing means 10 comprises a sleeve 12 having internal threads and a stopper 18 comprising external

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threads 17 complementary to internal threads on sleeve 12. Teflon tape 34 is placed on threads 17 to enhance the seal between sleeve 12 and stopper 18. It would have been obvious to one of ordinary skill in the art at the time of the present invention to apply the Teflon tape of Phillips to the threads 22 or 38 of Perler to enhance the seal between the first and second columns.

Response to Arguments

Applicant's arguments filed 10/05/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the volume of the first column is 3.5 cc) are not recited in the rejected claim(s) but merely implied from the description. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, even if the claims were to include these features the rejection in view of Perler would not be overcome. The volume of implant material to be delivered to a vertebral body during a vertebroplasty procedure is a variable quantity dependant upon the size of the vertebral body being operated upon which in many cases would be determined by the size of the patient. An infant, for example, would require a much smaller volume of implant material than a very large adult.

In response to Applicant's argument that the cited patents do not teach high pressure applicators capable of generating pressures of at least about 1000 psi, the Examiner maintains the position set forth in the above rejection (i.e., that that since the structure of the references cited is fully functionally equivalent if not identical to that claimed, the applicators of these references are capable of generating the pressures claimed.). Relative to the Fischer reference, Applicant has again relied on feature that are not recited in the rejected claims (i.e., that the threads on the inner wall of the first column are densely spaced). Furthermore, amending the claims to recite this feature still would not overcome the rejection(s) because "dense" is a relative term not easily or clearly defined without reference. There are certainly threads less dense than those disclosed by Fischer relative to which the threads of Fischer would be relatively dense.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is (571) 272-4717. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael B. Priddy

Michael B. Priddy
December 16, 2004

Kevin Shaver
KEVIN SHAVER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700